

**REMARKS****Amendments to the Claims**

Applicants presently amend claims 1 and 12 to change the limitation "such that said caller identity is transmittable" to "such that said caller identity is transmitted." Although Applicants have amended claims 1 and 12, Applicants do not concede that claims 1 and 12 were not patentable as originally claimed. In fact, Applicants reserve the right to pursue these originally filed claims in one or more continuation applications. Applicants submit that these amendments do not introduce any new matter and submit that the claims as currently amended are in condition for allowance.

**Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

Claims 1, 2, 4-9, 11-13, and 15-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action at page 2 states:

Regarding claims 1 and 12, the phrase "said caller identity is transmittable" is indefinite because it is unclear whether said caller identity is transmitted to the destination or said caller identity is not transmitted to the destination.

Applicants respectfully note in response, however, that claims 1 and 12 are amended in this Response to change the limitation "such that said caller identity is transmittable" to "such that said caller identity is transmitted," thereby removing any doubt as to whether "said caller identity is transmitted to the destination or said caller identity is not transmitted to the destination." In amending claims 1 and 12, Applicants in no way concede that the claims did not satisfy all requirements set forth in 35 U.S.C. § 112. Rather, Applicants amend claims 1 and 12 to move prosecution forward in the present case. Applicants submit that Applicants' claims properly satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, and Applicants respectfully request reconsideration of the rejections.

**Claim Rejections – 35 U.S.C. § 101**

Claims 24-25 and 27-30 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action on pages 3-5 states:

The Specification indicates that “computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and *transmission-type media, such as digital and analog communication links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions*”. Thus, reading independent claim 24 in light of the specification, the recited “computer readable medium” of these claims encompasses a carrier medium that conveys a signal.

Signals are not patentable under § 101.

In any event, *a carrier medium that conveys a signal* (e.g., a carrier wave) is distinguished from a tangible medium that *stores a signal* (e.g., a disk, memory, etc.), particularly with respect to the functionality of independent claim 24. This claim, in effect, call for means to interact with the computer to perform specific functions. It is our view that the computer cannot perform the claimed functions while the instructions are within signals conveyed by a carrier wave.

Specifically, information sent by the carrier wave conveying signals is transmitted by modulating the carrier wave or signal with the information. This information must be received and demodulated before the information is available for use. Thus, the information, *while on the carrier wave or signal*, is unavailable to the computer for performing the functions recited in independent claim 24. It is also likely that all the information necessary to perform the functions of claim 24 never exists within the carrier wave or signal at any one time. In other words, it is typical for information that is transmitted by signals conveyed by carrier waves to begin to be received at the receiver before all the information is transmitted. Therefore, it appears that program instructions for carrying out the claimed invention cannot exist while the information is being transmitted via signals conveyed by a carrier wave.

Furthermore, while the exemplary “transmission-type media” disclosed on page 29 of the Specification certainly implicates physical carriers of information, the disclosure hardly limits the carriers to these examples. Rather, nothing in the passage precludes the use of any tangible means of information carriage.

Thus, when read in light of the Specification, independent claim 24 includes both statutory subject matter (signals stored on a tangible medium) and non-statutory subject matter (signals conveyed by a carrier medium). According to USPTO guidelines, however, such claims must be amended to recite solely statutory subject matter.

For the foregoing reasons, independent claim 24 or the claims dependent thereon do not recite statutory subject matter under 35 U.S.C. § 101.

Applicants respectfully note in response, however, that Applicant's specification is amended in this Response to remove all references to "transmission-type media." In amending the specification, Applicants in no way concede that the claims did not satisfy all requirements set forth in 35 U.S.C. § 101. Rather, Applicants amend the specification to move prosecution forward in the present case. Applicants submit that Applicants' claims properly satisfy all requirements set forth in 35 U.S.C. § 101 and Applicants respectfully request reconsideration of the rejections.

### **Conclusion**

Applicants acknowledge with thanks the Office Action's indication of allowable subject matter in the present application. Applicants present the remarks and amendments above demonstrating that the case is in condition for allowance.

Claims 1, 2, 4-9, 11-13, and 15-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As discussed above, claims 1, 2, 4-9, 11-13, and 15-23 satisfy all requirements set forth in 35 U.S.C. § 112, second paragraph. As such, the rejection of claims 1, 2, 4-9, 11-13, and 15-23 under 35 U.S.C. § 112, second paragraph, should be withdrawn and the claims should be allowed.

Claims 24-25 and 27-30 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As discussed above, claims 24-25 and 27-30 satisfy all requirements set forth in 35 U.S.C. § 101. As such, the rejection of claims 24-25 and 27-

30 under 35 U.S.C. § 101 should be withdrawn and the claims should be allowed.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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